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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2625

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,228	Applicant(s) NAKAYASU ET AL.	
	Examiner Thierry L. Pham	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/28/06; 7/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 7/13/06.
- Claims 19-36 are pending; claims 1-18 had been canceled.
- IDS filed on 6/28/06 & 7/25/06 have been received and considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20, 21, 23, 28, 30, rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6522971), and in view of Fritsch (US 6247130).

Regarding claim 19, Tanaka teaches a print agent service (fig. 1) method, comprising:

- receiving a print request (wherein printing is based on a user request, col. 4, lines 52-57 and col. 6, lines 47, wherein printed output is generated based on user print request) and a user ID (registration code and password, col. 5, lines 59-65) from a client terminal (mobile 4, fig. 1);
- determining (step S2, fig. 6) whether the user indicated by the user ID has used the printing agent service in the past (past accessed history, fig. 6, col. 5, lines 15-25);
- retrieving a predetermined number of most recently used printing agent printer sites selected in the past by the user indicated by the user ID in response to determining that the user indicated by the user ID has used printing agent in the past (col. 5, lines 15-25);
- sending (sending service station to client terminal, col. 4, lines 32-57) to the client terminal, as candidates for printing agent printer sites (col. 4, lines 50-57) to be selected by the user;

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- receiving location information (location of user terminal 4, col. 4, lines 30-40) from the client terminal when the user ID indicates that the user has not used (first time access, col. 5, lines 25-35) the printing agent service in the past;
- retrieving (retrieving from service center database, fig. 2 & 6), in response to the location information (location of user terminal 4, col. 4, lines 30-40), a printing agent printer site nearest (closest service station having printer based on user's geographical location, col. 5, lines 10-15) to a location of the client terminal based on the location information;
- sending (sending service station to client terminal, col. 4, lines 32-57) to the client terminal, as a candidate for a printing agent printer site to be selected by a user, information indicating the printing agent printer site nearest (closest service station relative to location of user terminal, col. 5, lines 10-15) to the location of the client terminal in response to receiving the location information (location of user terminal 4, col. 4, lines 30-40);
- selecting (col. 2, lines 17-20) a printer agent printing site from the candidate site(s) sent (col. 4, lines 30-40) to the client terminal;
- receiving the printing agent printer site selected (col. 2, lines 20-23 and col. 4, lines 30-40) by the client terminal, and sending the printing data (print data, col. 4, lines 50-60) of the print request at the selected printing agent printer site; and
- printing (printing, fig. 1, col. 4, lines 50-57) the print data at the selected printing agent printer site (service station having a printer, fig. 1) when a client who has sent the print request instructs printout at the selected printing agent printer site.

Tanaka teaches a service database containing user's history of services used in the past but fails to explicitly teach and/or suggest information indicating the predetermined number of most recently used printing agent printer sites.

Fritsch teaches sending a predetermined number past used sites/services to the client terminal for display (fig. 2A & 2B, col. 6, lines 49-61).

It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before. The motivation for providing such history to the user would have been allow the user to use the services

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they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.

Regarding claim 21, Tanaka teaches the printing agent service method according to claim 19, wherein the sending steps sending map information showing the nearest (col. 5, lines 10-15) agent printer site based on the location information (col. 7, lines 1-3).

Regarding claim 23, Tanaka further teaches the printing agent service method according to claim 19, wherein the retrieving a printing agent printer site nearest to a location of the client terminal comprises retrieving a current location of the client terminal based on the location information (col. 7, lines 24-25), and retrieving the printing agent printer site nearest to the current location (col. 8, lines 13-30).

Regarding claims 20, 28, and 30 recite limitations that are similar and in the same scope of invention as to those in claims 19, 21, and 23 above (respectively); therefore, claims 20, 28, and 30 are rejected for the same rejection rationale/basis as described in claims 19, 21, and 23 above (respectively).

Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Britt et al. (US 6647267).

Regarding claims 22 and 29, Tanaka does not specifically teach the location information being by GPS.

Britt teaches server receives GPS information from said client terminal (col. 2 line 30, Fig. 1).

It would have been obvious to one of ordinary skill in the art that that Tanaka's system of sending location information and being able to provide maps could have been done with GPS. The motivation for doing so would have been to provide a well-known and exact system of location determination. Further, Tanaka also teaches receiving the

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current location of the user's mobile device (col. 7 lines 23-26), thus it would have also been obvious to use GPS for this to determine exact location of the user.

Claims 31 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Minari (US 6809831).

Regarding claims 31 and 24, while Tanaka teaches the outputting of a print job and letting the user know where the print job is outputted (col. 6 lines 50-53), the combination of

Tanaka and Fritsch does not specifically teach sending the printing results to the client terminal.

Minari teaches sending printing results to a user (Fig. 8, wherein the print result is sent to the printer controller and from there to the user application at the host computer).

It would have been obvious to one of ordinary skill in the art that letting a user know the results of their print job would have been beneficial to system where the user notified where the print job is being output. The motivation for doing so would have been to only have the user travel to the site to pick up the job when the job has been output correctly and when the job has not been output correctly, notifying the user so they do not travel and waste time to retrieve a job that hasn't been output correctly.

Claims 32 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Kawai et al. (US 6404994).

Regarding claims 32 and 25, while the combination of Tanaka and Fritsch teaches fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example printing services]), the combination does not specifically teach how the user pays for the printing services including that the server automatically debits a specified account for an agent printing fee.

Kawai teaches server (copier 18 includes printing server functionality as shown in Fig. 4) automatically debits a specified account for a printing fee (col. 5 lines 15-20,

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wherein charging device automatically debits a prepaid card, which is the user account information).

It would have been obvious that the automatic payment system of Kawai could have been used to pay for the printing services specified in the combination. The motivation for doing so would have been to allow users quick and automatic debit of their accounts so they would not have to deal with a person (thus quicker) or pay in cash (thus easier). Further, Kawai teaches the charging system is typically at a store (col. 4 line 12) and the printing services rendered in the combination are taught as implement able in a store (see Tanaka Fig. 11A, wherein the stores have specific prices for services).

Claims 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Satomi et al. (US 2004/0039641).

Regarding claims 26 and 33, the combination of Tanaka and Fritsch do not specifically teach placing adds on printouts or giving discounts accordingly.

However, Satomi teaches printing that includes an advertisement to a printer in accordance with an advertisement-included printing specification and discounts a printing fee in accordance with the printing that includes an advertisement (abstract and Figs. 17, 29, 53-56, 70, 77, 79 and their descriptions - other pertinent sections of the reference should be also reviewed, given figures just examples).

It would have been obvious to one of ordinary skill in the art to be able to include advertisements in the printouts as done in Satomi. A motivation for doing so would have been the clear motivation of reducing cost for the user and securing advertising space for marketers.

Claims 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Hanzawa (US 5506661)

Regarding claim 27 & 34, while the combination teaches fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example

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printing services]), the combination does not specifically teach sending the client the fee in accordance with the printing results.

Hanzawa teaches that it is well known in the art to notify a user of the cost of printing once the printing has been completed (col. 1 lines 19-22, wherein the fee is calculated after printing, and col. 1 line 11, wherein it is displayed for a user).

It would have been obvious to one of ordinary skill in the art that a printing fee for the print job could have been calculated and sent to the user in the combined system. The motivation for notifying a user of the cost of a printed print job would have been to allow the user to have the proper payment for the print job when they arrived at the service station of Tanaka to pick up their print job.

Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (6522971), Fritsch (US 6247130), Minari (US 6809831), and further in view of Kawai et al (US 6404994).

Regarding claims 35-36, Tanaka teaches a printing agent service system (Fig. 1), comprising: a database (Fig. 2 shows the databases located at the central service center that has information on the sites in the system, col. 3 lines 24-30) for storing printing agent printer sites (sites 3, Fig. 1); and a server (service center 2; col. 3 lines 2-6) for receiving a user ID (registration code and password for example; col. 55 line 57), a print request (col. 1 lines 26 and 62, col. 3 lines 36-45, wherein printing is based on a user request, col. 4 lines 52-57 and 64, col. 6 line 47, wherein printed output is generated based on user print request) and location information from a client terminal (col. 4 lines 36-37 and 9-10), and retrieving, from the database (col. 4 lines 33-40), the printing agent printer site nearest to the location of the client terminal in accordance with said location information (Figs. 11A and 11B show the closest requested services to a user after it has been determined based on the user location; col. 8 lines 13-22), wherein the server sends information of the nearest printing agent printer site to the client terminal for display (Figs. 11A and 11B, col. 8 lines 14-22), receives from the client terminal a specified printing agent printer site (col. 8 lines 31-32), and sends the print request to a printer at the specified printing agent printer site (col. 4 lines 52-57, where a type of

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service that is used is printing and specifically line 52, where the data is sent from the server to the station - also col. 6 lines 48-52), and

While Tanaka teaches logging into the server system (Fig. 6, col. 5 lines 10-17 of Tanaka) with user information (registration code and password for example; col. 5 line 57) as well as teaching having the user history of the user stored at the server in the database (col. 5 lines 18-25) including services used in the past (col. 5 line 24), Tanaka does not specifically teach that this history information including past used sites/services is sent to the client terminal.

Fritsch teaches sending a predetermined number (the number is determined before the user logs into the system, thus predetermined before the current session) past used sites/services to the client terminal for display (Fig. 2A & 2B; col. 6 lines 49-61).

It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before. The motivation for providing such history to the user would have been to allow the user to use services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.

Tanaka and Fritsch does not specifically teach sending the printing results to the client terminal.

Minari teaches sending printing results to a user (Fig. 8, wherein the print result is sent to the printer controller and from there to the user application at the host computer).

It would have been obvious to one of ordinary skill in the art that letting a user know the results of their print job would have been beneficial to system where the user notified where the print job is being output. The motivation for doing so would have been to only have the user travel to the site to pick up the job when the job has been output correctly and when the job has not been output correctly, notifying the user so they do not travel and waste time to retrieve a job that hasn't been output correctly.

While the combination of Tanaka and Fritsch teach fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example printing services]), the combination does not specifically teach how the user pays for the printing

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services including that the server automatically debits a specified account for an agent printing fee.

Kawai teaches server (copier 18 includes printing server functionality as shown in Fig. 4) automatically debits a specified account for a printing fee (col. 5 lines 15-20, wherein charging device automatically debits a prepaid card, which is the user account information).

It would have been obvious that the automatic payment system of Kawai could have been used to pay for the printing services specified in the combination. The motivation for doing so would have been to allow users quick and automatic debit of their accounts so they would not have to deal with a person (thus quicker) or pay in cash (thus easier). Further, Kawai teaches the charging system is typically at a store (col. 4 line 12) and the printing services rendered in the combination are taught as implement able in a store (see Tanaka Fig. 11A, wherein the stores have specific prices for services).

Response to Arguments

Applicant's arguments filed 7/13/06 have been fully considered but they are not persuasive.

- Regarding claims 19-20, the applicants argued the cited prior arts of record fail to teach and/or suggest information indicating most recently used printing agent printer sites selected in the past to determine the closest printer sites available.

Tanaka teaches a service center with database for storing user's past accessed history (past accessed services, col. 5, lines 10-33). Tanaka also teaches an example of locating a closest service station based upon user's current geographical location (col. 5, lines 13-17). Tanaka teaches a well-known example of storing history of past accessed to the service center but fails to explicitly indicate which past service station has been used for services (i.e. printing). Fritsch teaches a well-known example of storing and displaying previously used sites for services. Therefore, it would be obvious for Tanaka to store information relating to both past accessed to service center and previously used service station in order to enhance its service (i.e. would have been allow the user to user the

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services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry).

- Applicant's arguments, see pages 10-11, filed 7/13/06, with respect to claims 19-34 have been fully considered and are persuasive. The 112, 1st and 2nd paragraph rejections of claims 19-34 have been withdrawn.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



GABRIEL I. GARCIA
PRIMARY EXAMINER